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EXAMINER

METZMAIER, DANIEL S

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte FRIEDRICH JONAS,
ANDREAS ELSCHNER, KLAUS WUSSOW,
and ROLF WEHRMANN

Appeal 2009-000622
Application 10/057,027
Technology Center 1700

Decided: September 21, 2009

Before ADRIENE LEPIANE HANLON, CHARLES F. WARREN, and
PETER F. KRATZ, *Administrative Patent Judges*.

WARREN, *Administrative Patent Judge*.

DECISION ON APPEAL

Applicants appeal to the Board from the decision of the Primary Examiner finally rejecting claims 1, 4, 5, and 9 in the Office Action mailed September 22, 2006. 35 U.S.C. §§ 6 and 134(a) (2002); 37 C.F.R. § 41.31(a) (2007).

We affirm the decision of the Primary Examiner.

Claim 1, as it stands of record in the Amendment filed June 22, 2006,¹ illustrates Appellants' invention of a dispersion comprising, among other things, cationic 3,4-polyalkylenedioxythiophenes, and is representative of the claims on appeal:

1. A dispersion comprising:
polyanions;
cationic 3,4-polyalkylenedioxythiophenes; and
a solvent comprising water and optionally alcohol,
wherein said dispersion has a weight ratio of cationic 3,4-polyalkylenedioxythiophene to polyanion of from 1:8 to 1:25, and 90% by weight of the particles of the dispersion being less than 40 nm.

Appellants request review of the ground of rejection of appealed claims 1, 4, 5, and 9 under 35 U.S.C. § 112, first paragraph, as being based on a specification which does not provide a written description of the manner of making the claimed invention, advanced on appeal by the Examiner. Br. 5;² Ans. 3.

Appellants argue the claims as a group. *See generally* Br. We decide this appeal based on claim 1. 37 C.F.R. § 41.37(c)(1)(vii) (2007).

Issue

The issue in this appeal is whether Appellants have established that one skilled in this art can make the claimed dispersion encompassed by representative appealed independent claim 1 from the disclosure in the written description in the Specification to use the dispersion prepared in accordance with Example 2 of EP-A 991 303 as starting material.

¹ The copy of claim 1 in the Claim Appendix contains error. *See* Br. 9.

Findings of Fact

We find the written description in the Specification as filed³ contains the following disclosures:

EP-A 991 303 discloses 3,4-polyalkylenedioxythiophenes having particle sizes of < 250 nm and conductivities of the dried polymers of < 2 S/cm, corresponding to a resistivity of 0.5 Ω cm. . . .

Surprisingly, it has now been found that by further reducing the size of the particles, the resistance of the 3,4-polyalkylenedioxythiophenes described in EP-A 991 303 can be significantly increased without the desired hole-injecting action being lost.

Spec. 3:3-13.

. . . These dispersions were prepared starting from dispersions in accordance with EP-A 991 303 by subsequent comminution of the particles.

Spec. 4:6-8.

The dispersions preferably comprise only small amounts of ionic impurities in the limits as described in EP-A 991 303.

Spec. 6:20-21.

1 liter of a 1.4% by weight 3,4-polyalkylenedioxythiophene/polystyrene sulfonate dispersion having a weight ratio of the 3,4-polyalkylenedioxythiophene to polystyrene sulfonic acid of 1:8, prepared by evaporating a 3,4-polyalkylenedioxythiophene/polystyrene sulfonate dispersion in accordance with Example 2 from EP-A 991 303 was homogenized twice using a high-pressure homogenizer at 700 bar and with a nozzle diameter of 0.1 mm.

² We considered the Brief filed October 2, 2007, and the Examiner's Answer mailed December 19, 2007.

³ Appellants amended the Specification back to its original disclosure in the Amendment filed June 22, 2006.

Spec. 10:2-9; *see also* Spec. 10:18-27, 11:4-13, and Table 1.

We find EP 0 991 303 A2 is a European Patent Application published April 5, 2000.

Opinion

Appellants do not dispute the Examiner's position that the method of making the 3,4-polyalkylenedioxy-thiophene/polystyrene sulfonate dispersion starting material specified in Example 2 of EP-A 991 303 is "essential material" required to make the claimed dispersion invention; that the Specification does not contain a description of the preparation of the 3,4-polyalkylenedioxy-thiophene/polystyrene sulfonate dispersion starting material other than to prepare the same in accordance with Example 2 of EP-A 991 303; and that there is no language in the written description in the Specification expressly incorporating EP-A 991 303 by reference into the Application. Ans. 3-4; Br. 6-7.

Appellants essentially argue one skilled in the art in possession of EP-A 991 303 would thus be in possession of the first step of the process, that is, the preparation of the 3,4-polyalkylenedioxy-thiophene/polystyrene sulfonate dispersion starting material, disclosed to prepare the claimed dispersion as described in the written description in the Specification. Br. 5-7. In this respect, Appellants state the disclosure in the Specification "confirms that the first step for preparing the applicant's dispersion is preparing 3,4-polyalkylenedioxy-thiophene/polystyrene sulfonate dispersion in known [sic] by one of ordinary skill in the art and refers to EP 0991303," and that "[a] person skilled in the art would know how to make the

dispersion according to the first step, i.e. example 2 of EP 0991 303 discloses the preparation of such a dispersion in a known manner.” Br. 6.

We disagree with Appellant’s position. It is axiomatic that the written description of a claimed invention in a specification must contain the full disclosure of all information essential for one skilled in the art to make and use the claimed invention in order to satisfy the provisions of § 112, first paragraph. Such “essential material” can be incorporated by reference only to a United States patent or United States patent application publication. 37 C.F.R. §§ 1.57(b)(1), (b)(2), and (c)(1) (September 21, 2004); *see* Manual of Patent Examining Procedure (MPEP) § 608.01(p), I. Incorporation By Reference (8th ed., Rev. 5, August 2006). *See, e.g., General Elec. Co. v. Brenner*, 407 F.2d 1258, 1260 (D.C. Cir. 1968) (“[T]he Commissioner has the authority to issue a patent upon an application wherein the disclosure incorporates, by reference, (and relies thereon) certain portions of a disclosure of an existing patent provided that this information relied upon is available to the public.”).

On this record, even if one person skilled in the art was in possession of EP-A 991 303, the “essentially material” in this foreign patent literature document is not readily available to the public. *General Elec. Co.*, 407 F.2d at 1260; *see also* MPEP § 608.01(p), I. Incorporation By Reference (8th ed., Rev. 5, August 2006) (“The incorporation by reference practice with respect to applications which issue as U.S. patents provides the public with a patent disclosure which minimizes the public’s burden to search for and obtain copies of documents incorporated by reference which may not be readily available.”). Furthermore, Appellants have not established that one skilled

in this art can make the claimed dispersion encompassed by representative appealed independent claim 1 from the disclosure in the written description in the Specification to use the dispersion prepared in accordance with Example 2 of EP-A 991 303 without being in possession of EP-A 991 303. Appellants' recourse is to correct the matter as provided in 37 C.F.R. §§ 1.57(g). *See* MPEP § 608.01(p), I. Incorporation By Reference, 2, Improper Incorporation (8th ed., Rev. 5, August 2006).

Accordingly, Appellants have not rebutted the Examiner's prima facie case, and thus, we affirm the ground of rejection of appealed claims 1, 4, 5, and 9 under 35 U.S.C. § 112, first paragraph.

The Primary Examiner's decision is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(v).

AFFIRMED

kmm

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